

## **REMARKS**

### **Specification**

The "CROSS REFERENCE TO RELATED APPLICATIONS" section has been amended to update the priority data associated with the subject application and to correct minor formalistic errors in the priority data.

### **Double Patenting**

Claims 63, 70-71, 75, 98-101, 103-107, 109 and 112 have been rejected under the judicially created doctrine of obviousness-type double patenting over various claims of commonly owned U.S. Patent No. 6,695,882. In response to the obviousness-type double patenting rejection, the Applicant has submitted a Terminal Disclaimer herewith along with the requisite fee, and respectfully requests withdrawal of the double patenting rejection.

### **Claim Rejections – 35 USC §102**

Claims 63, 70-74, and 76-97 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,371,988 to Pafford et al. (hereinafter "the Pafford reference"). It is well established that "an invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989).

### **Independent Claim 63 and Dependent Claims 70 and 71**

As set forth on pages 2 and 3 of the Office Action, independent claim 63 and dependent claims 70 and 71 have been rejected as being anticipated by the Pafford reference. The Applicant respectfully traverses these rejections for at least the following reasons.

The Office Action asserts that "Pafford discloses the invention as currently claimed noting figures 6-8, 24 and 37 comprising: A method of providing a spacer (i.e. 20, 20', 40), the spacer having a body, a wall, wherein the wall has an outer surface including a concave portion (notice the concave section shown in figure along the wall) which defines a chamber (25), and a

channel (49) defined in the wall in communication with the chamber and the outer surface . . .” (emphasis added).

However, the Applicant notes that the element 49 is a tool engaging hole which is threaded to receive the threaded tip 65 of the inserter tool 60 illustrated in Figure 9. Even assuming arguendo that the tool engaging hole 49 could be construed as a channel defined in a wall of the spacer and in communication with an outer surface of the spacer, the tool engaging hole 49 is not in communication with the chamber 25. Specifically, Figure 5 illustrates a cross-sectional view of a spacer which is representative of each of the spacer embodiments 20, 20' and 40. As shown in Exhibit A attached hereto, the tool engaging hole 49 is clearly not “in communication with” the chamber 25, as recited in independent claim 63. Instead, the tool engaging hole 49 has a depth that stops well short of the chamber 25. Moreover, as shown in Figure 9, the threaded tip 65 of the inserter tool 60 has a very short length. Accordingly, there would be no motivation or suggestion to increase the depth of the tool engaging hole 49 to intersect the chamber 25.

Since the Pafford reference does not teach or suggest each and every element and feature recited in independent claim 63, the Applicant submits that independent claim 63 is patentable, and requests withdrawal of the rejection of independent claim 63 and allowance of the same. Claims 70 and 71 depend from independent claim 63, and are patentable for at least the reasons supporting the patentability of independent base claim 63.

#### **Independent Claim 72 and Dependent Claims 73-97**

As an initial matter, dependent claim 75 was rejected solely under the judicially created doctrine of obviousness-type double patenting. As indicated above, the double patenting rejection has been obviated via the filing of a Terminal Disclaimer. Accordingly, dependent claim 75 would appear to be allowable if rewritten in independent form. To that end, the Applicant has rewritten claim 75 in independent form and allowance of the same is respectfully requested.

Independent claim 72 has been rejected as being anticipated by the Pafford reference. The Applicant has amended independent claim 72 to recite “said graft defining a channel

extending between said chamber and said outer surface in a direction transverse to said second axis”. As indicated above with regard to independent claim 63, the Pafford reference fails to disclose a channel extending between the chamber 25 and an outer surface of the spacer. Even assuming arguendo that the tool engaging hole 49 could be construed as a channel defined in a wall of the spacer and in communication with an outer surface of the spacer, as discussed above, the tool engaging hole 49 is clearly not in communication with the chamber 25 (e.g., “extending between said chamber and said outer surface”). (See Exhibit A).

Since the Pafford reference does not teach or suggest each and every element and feature recited in independent claim 72, as now amended, the Applicant submits that independent claim 72 is patentable, and requests withdrawal of the rejection of independent claim 72 and allowance of the same. Claims 73-97 depend from independent claim 72, and are patentable for at least the reasons supporting the patentability of independent base claim 72.

**Independent Claim 98 and Dependent Claims 99-114**

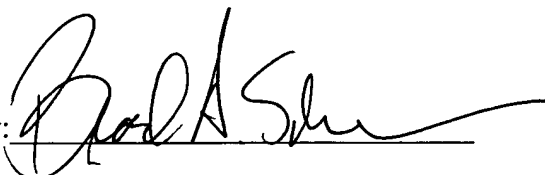
Independent claim 98 and dependent claims 99-114 were rejected solely under the judicially created doctrine of obviousness-type double patenting. As indicated above, the double patenting rejection has been obviated via the filing of a Terminal Disclaimer. Accordingly, claims 98-114 are submitted to be in condition for allowance.

### CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the Applicant's application is now in condition for allowance with pending claims 63 and 70-114.

Reconsideration of the subject application is respectfully requested. Timely action towards a Notice of Allowability is hereby solicited. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the subject application.

Respectfully submitted,

By: 

Brad A. Schepers  
Reg. No. 45,431  
Krieg DeVault LLP  
One Indiana Square, Suite 2800  
Indianapolis, Indiana 46204-2079  
(317) 238-6334 (voice)  
(317) 238-6371 (facsimile)